

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re application of: Xin Liu et al.

Application No.: 10/376,692

Filed: February 27, 2003

Group No.: 1654

For: GERMINATION ACTIVATED *GANODERMA LUCIDUM* SPORES AND METHOD FOR PRODUCING THE SAME

Examiner: Christopher Robin Tate

Current status and location of application (if known): Response to Ex parte Quayle Action entered and forwarded to Examiner

Assistant Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22331-1450

ATTENTION:

PROTEST UNDER 37 C.F.R. § 1.291(a)

IDENTIFICATION OF APPLICATION

1. This is a protest against the above identified
- ☐ pending application.
 - ☒ reissue application.

LISTING OF INFORMATION RELIED ON

2. Listed below are the patents, publications or other information relied upon.

U.S. Patent No. 6,468,542 ('542 Patent)
In re Goldstein, 16 USPQ2d 1963 (Com'r PTO 1988)
Baker Hughes Inc. v. Kirk, 38 USPQ29 1885 (DC. DC. 1995)

RELEVANCE OF LISTED ITEMS

3. A concise explanation of the relevance of each listed item follows:

The '542 Patent is the Patent being sought to reissued.

The case law is relevant to issues involving contested title to patents and required consent to file a reissue application, respectively.

4. Statement of Facts

A. U. S. Patent No. 6,468,542 sets forth two Inventors and no assignee. The listed inventors are Xin Liu (Building No. 391, 135 Xingang Xi Road, Guangzhou, CN) and Chee-Keung Chung; (Room 2018, Argyle Centre, 688 Nathan Rd., Mongkok, Kowloon, HK).

B. The undersigned, Dr. Fei-Fei Chao, is listed as the Attorney in the Attorney, Agent or Firm field of the U.S. Patent for which reissue is being sought.

C. The undersigned represents Chee-Keung Chung in matters before the U. S. Patent and Trademark Office and is reasonably certain that he has not assigned his rights in the patent and therefore remains co-owner of the patent for which reissue is being sought.

D. The undersigned has reviewed the reissue file and has observed that there is no mention of Chee-Keung Chung as a co-inventor and participant in the reissue process. His signature is not apparent in the file on any document. An object of the reissue appears to be the removal of Chee-Keung Chung as a co-inventor.

E. The MPEP ¶ 1410.01 indicates that when Applicant makes no statement as to the presence of an Assignee, there is a presumption of the existence of an Assignee. The Examiner is to so state this in the first office action. The first Office action is silent on this matter. Xin Liu's representative is also silent on this matter. There is no evidence in the file wrapper that establishes sole ownership interest in Xin Liu or an Assignee. No mention is made in the file wrapper as to Chee-Keung Chung's ownership interest.

F. There is no evidence in the reissue application that Xin Liu's representative made an inquiry as to the ownership interest of Chee-Keung Chung or his status as a co-inventor.

G. The reissue file as it now stands suggests that Xin Liu's representative is dismissive of Chee-Keung Chung as a co-inventor and has filed the reissue application without the assent of all those having an apparent ownership interest in the patent, a violation of 37 CFR §§ 1.47 and 1.175.

H. Further, the reissue file as it now stands suggests that all the requirements of 35 U.S.C §251 have not been met. The record suggests that Chee-Keung Chung has an ownership interest and has not consented to the reissue of the patent.

I. The undersigned also notices that in the file wrapper, on November 24, 2003, Xin Liu's representative filed with the PTO a "Statement as to Loss of Original Patent" signed by Xin Liu. The undersigned states that the Letter Patent has never been lost and is still in the rightful possession of Chee-Keung Chung. Xin Liu and/or his representative never requested Chee-Keung Chung to provide them with the Letter Patent so that its surrender could be offered in the context of the reissue.

COPIES OF LISTED ITEMS

5. A copy of each listed patent or publication or other item of information in written form, or at least the pertinent portions thereof, is attached.

SERVICE OF PAPERS

6. (a) p Service of a complete copy of these papers was made by depositing a copy (copies) of these papers with the United States Postal service on , each with sufficient postage as first class mail in an envelope(s) addressed to the following:

Mr. Otto Lee, Esq.
Intellectual Property Law Group LLP
Old Bank of America Building
12 South First Street, 12th Floor
San Jose, California 95113

ACKNOWLEDGEMENT OF PROTEST BY PTO

- 7.
- x Please acknowledge receipt of this protest by stamping and returning the attached self-addressed postcard.
 - x Please also acknowledge entry of this protest in the reissue application file.

IDENTIFICATION OF PROTESTOR

Date: January 13, 2004

Fei-Fei Chao, Ph.D.
(type or print name of protestor)

Fei-Fei Chao
Signature of Protestor Reg. No.: 43,538

P.O. Box 34385
P.O. Address

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DC2-DOCS1-515175

Fei-Fei Chao, Ph.D.
(202)-344-8011
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January 12, 2004

VIA FACSIMILEMr. Otto Lee
Intellectual Property Law Group LLP
Old Bank of America Building
12 South First Street
Twelfth Floor Suite 1205
San Jose, California 95113Re: Requesting for Consent or Refusal to Sign Reissue
Applications of U.S. Patent No. 6,316,002 and 6,468,542

Dear Mr. Lee:

As I indicated in my telephone conversation with you dated January 12, 2003, my firm represents Dr. Chee-Keung Chung of Hong Kong, who is one of the inventors in U.S. Patent No. 6,316,002 and 6,468,542. These two patents have another inventor, who is your client Mr. Xin Liu, and no assignee. Dr. Chung recently instructed us to file reissue applications for these two U.S. patents. Because Dr. Chung is currently in litigation against Mr. Liu, we believe that it would be more appropriate for us to communicate with you to request that Mr. Liu sign the Oath/Declaration forms that we prepared for these two reissue applications. Enclosed please find the Oath/Declaration and "Preliminary Amendment, Status of Claims, and Statement of Support" document for each of the reissue applications.

We intend to move our applications promptly. Please let us know by return e-mail or fax, on or before **January 14, 2004**, whether Mr. Liu is willing to sign on the Oath/Declaration or not. If so, please return Mr. Liu's signed Oath/Declaration forms to us by fax, no later than January 14, 2004. If not, or if Mr. Liu is uncertain whether he is willing to sign or not, we will seek to file a petition under 37 CFR § 1.47(a) to advance our reissue applications.

Thank you for your consideration and we look forward to hearing from you soon.

Very truly yours,



Fei-Fei Chao, Ph.D.

Attorney/LAA: F i-Fei Chao/rdk
Date Filed: January 13, 2004

Venable Filing Number	Practitioner's Docket No.: Richards.Liu.RE1	Filing Date
Atty. Docket No.	Re: Germination Activated Ganoderma Lucidum Spores and Method for Producing the Same	
Application No.:	10/376,845	Filing Date: February 27, 2003
In re application of:	Xin Liu et al.	Issue Date
Trademark:		Trademark Reg. No:
Opposition/Cancellation No:		

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

<input checked="" type="checkbox"/>	Protest Under 37 C.F.R. § 1.291(a) – Form 9-31	Filing Fee
<input checked="" type="checkbox"/>	Petition Under 37 C.F.R. § 1.182 – Form 19-8	Issue Fee
<input checked="" type="checkbox"/>	Postcard	Publication Fee
	Translation of International Application	
	Issue Fee and Publication Fee Cover Sheet	Recordation/Indexing Fee
	Issue Fee Transmittal – Part B	
	Letter to Official Draftsperson with five (5) sheets of drawings	
	Appeal Brief (in triplicate)	10 copies of patent
	Assignment w/Cover Sheet	
	Issue Fee Part B Transmittal with check for	Notice of Appeal Fee
	Information Disclosure Statement	
	Form PTO-1449	Brief on Appeal Fee
	Letter	
	Request for Corrected Filing Receipt with copy of red-lined corrections to Filing Receipt	Oral Hearing Request Fee
	Request for Oral Hearing	Petition Fee
	Confirmation of Hearing Petition	
	Letter Under 37 CFR 1.28 (c)	
	Maintenance Fee Transmittal	Maintenance Fee
	TM Statement of Use	
	Declaration Under 8	
	Declaration Under 8 and 15	
	TM renewal Application	8 Affidavit Fee
	Notice of Opposition	
	Supplemental Search Report and Annex	TM Renewal Application Fee
	Postcard	
	Change of Address	Notice of Opposition Fee

Fee: \$0

Check Number